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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,752	09/17/2003	Tohm Den	03500.014806.1	3824
5514	7590	03/14/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DIAMOND, ALAN D	
		ART UNIT	PAPER NUMBER	
		1753		

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,752	DEN, TOHRU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Diamond	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 January 2005 and 31 January 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 42 and 44-50 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 42 and 44-50 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 July 2004 and 17 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/665,983.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on January 31, 2005 and January 6, 2005 have been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 46, at line 3, the term "direct transition type semiconductor" is indefinite because it is subjective. It is not clear how close to being a direct transition semiconductor the semiconductor must be in order to be considered a "direct transition type semiconductor". It is suggested that "type" be deleted from line 3 of claim 46.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 42, 44-48, and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S.

Patent No. 6,649,824 (Den et al) in view of Skotheim (U.S. Patent 4,190,950). Claim 1 of Den et al teaches a dye-sensitized photoelectric conversion device comprising an electron acceptive charge transfer layer, an electron donative charge transfer layer, and a light absorption layer existing between the charge transfer layers, and either one of the charge transfer layers is a semiconductor acicular crystal layer comprising an aggregate of acicular crystals, and wherein the acicular crystals comprise a metal oxide. With respect to instant claim 44, see claims 9-11 of Den et al. With respect to instant claims 45 and 50, see claims 3 and 4 in Den et al. With respect to instant claim 47, see claim 26 in Den et al. With respect to claim 48, the requirement that the angle between the axial direction of the acicular crystals and the surface of the substrate is 60 degrees or more is encompassed by the claims of Den et al, in view of Figures 1B, 1D, 3B, 3D, 4A-4D, 5A-5D, 9A, and 9B, in Den et al which clearly show an angle of greater than 60 degrees. The claims of Den et al teach the limitations of the instant claims, the difference being that the claims of Den et al do not specifically teach that said light absorption layer is a semiconductor. Skotheim teaches dye-sensitized solar cells,

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wherein, as seen in Skotheim's Figure 3, the dye-sensitized solar cells can be stacked. Said Figure 3 shows four stacked cells 10, 10', 10", 10"". Stacking of the solar cells is done to achieve higher efficiency by using dyes that absorb at different wavelengths in the stacked cells (see col. 4, lines 26-50). Skotheim uses the same semiconductors for its dye-sensitized semiconductor layer as in the claims of Den et al, i.e., titanium oxide, zinc oxide, or tin oxide (see col. 3, lines 55-59, in Skotheim; and claims 9-11 in said parent). The titanium oxide, zinc oxide, or tin oxide will absorb some light, even if it is only a relatively small or a minute amount compared to the dye (see col. 3, lines 55-59, of Skotheim). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared the dye-sensitized photoelectric conversion device in the claims of Den et al as a stacked device wherein, for example, four cells, are stacked on each other, because stacking is done to achieve higher efficiency by using dyes that absorb at different wavelengths in the stacked devices, as taught by Skotheim. The titanium oxide, zinc oxide, or tin oxide semiconductor layer in a middle cell would then encompass the semiconductor of the instant light absorption region. This semiconductor will be between the electron acceptive charge transfer layer of the top (or bottom) cell and the electron donative charge transfer layer of the bottom (or top) cell. As noted above, the titanium oxide, zinc oxide, or tin oxide will absorb some light, even if it is only a relatively small or a minute amount compared to the dye. Furthermore, with respect to instant claim 46, said titanium oxide, zinc oxide, and tin oxide are direct transition semiconductors. With respect to the electrode regions recited

in instant claim 42, these are conventional in the art to make an operative photoelectric device, and Skotheim clearly has them in its Figures 1 and 3.

6. Claim 49 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,649,824 (Den et al) in view of Skotheim (U.S. Patent 4,190,950) as applied to claims 42, 44-48, and 50 above, and further in view of Tchernev (U.S. Patent 3,925,212) and Akuto et al (U.S. Patent 5,346,785). The claims of Den et al, in view of Skotheim, as relied upon for the reasons recited above, teach the limitations of claim 49, the difference being that the claims of Den et al, in view of Skotheim, do not specifically teach the use of Cul or NiO for the semiconductor, in place of said titanium oxide, zinc oxide, or tin oxide. Tchernev teaches that NiO, titanium dioxide and zinc oxide can be substituted for each other as the semiconductor in a solar energy conversion device (see col. 5, lines 27-36). Akuto et al teaches that Cul, titanium dioxide and zinc oxide can be substituted for each other as the semiconductor in a photoelectrode (see col. 12, lines 15-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted NiO or Cul for the titanium dioxide or zinc oxide in the photoelectric conversion device in the claims of Den et al, in view of Skotheim, because the substitution of art recognized equivalents, as shown by Tchernev and Akuto et al would have been with the level of ordinary skill in the art.

7. Claims 42, 44-48, and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 12 of copending Application No. 10/959,177 (Okura et al) in view of Skotheim (U.S.

Patent 4,190,950). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 of Okura et al teaches a photoelectric conversion device comprising an electron acceptive charge transporting layer, an electron donative charge transporting layer, and a light absorption layer existing between the charge transporting layers, and wherein electron acceptive charge transporting layer comprises a zinc oxide acicular crystal structure, and wherein the zinc oxide is formed using the electrodeposition method recited at the last four lines of the claim. When said claims 11 and 12 are read in light of Okura et al's specification, in particular Examples 10-12 at pages 44-52 which refer to Figure 1B, it is seen that the zinc oxide crystals are an aggregate of acicular crystals, have an angle between the axial direction of the acicular crystal and the surface of the substrate of 60 degrees or more (see Figure 1B), and that the photoelectric conversion device has zinc oxide having the aspect ratio in instant claims 45 and 50 (see page 45, lines 12-14; page 47, lines 25-27; and page 50, lines 9-11). With respect to claim 47, in each of Okura et al's Examples 10-12 (i.e., the examples where a photoelectric conversion device is prepared), the zinc oxide has a dye adsorbed on its surface, and this dye encompasses the particle of said claim 47. The claims of Okura et al teach the limitations of the instant claims, the difference being that the claims of Okura et al do not specifically teach that said light absorption layer is a semiconductor. Skotheim teaches dye-sensitized solar cells, wherein, as seen in Skotheim's Figure 3, the dye-sensitized solar cells can be stacked. Said Figure 3 shows four stacked cells 10, 10', 10'', 10'''. Stacking of the solar cells is done to achieve higher efficiency by using dyes that absorb

at different wavelengths in the stacked cells (see col. 4, lines 26-50). Skotheim uses the same semiconductor for its dye-sensitized semiconductor layer as in the claims of Okura et al, i.e. zinc oxide (see col. 3, lines 55-59, in Skotheim). The zinc oxide will absorb some light, even if it is only a relatively small or a minute amount compared to the dye (see col. 3, lines 55-59, of Skotheim). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared the photoelectric conversion device in the claims of Okura et al as a stacked device wherein, for example, four cells are stacked on each other, because stacking is done to achieve higher efficiency by using dyes that absorb at different wavelengths in the stacked devices, as taught by Skotheim. The zinc oxide semiconductor layer in a middle cell would then encompass the semiconductor of the instant light absorption region. This semiconductor will be between the electron acceptive charge transporting layer of the top (or bottom) cell and the electron donative charge transporting layer of the bottom (or top) cell. As noted above zinc oxide will absorb some light, even if it is only a relatively small or a minute amount compared to the dye. Furthermore, with respect to instant claim 46 zinc oxide is a direct transition semiconductor. With respect to the electrode regions recited in instant claim 42, these are conventional in the art to make an operative photoelectric device, and Skotheim clearly has them in its Figures 1 and 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

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8. Applicant's arguments filed January 6, 2005 have been fully considered but they are not persuasive.

Applicant argues that Claims 42, 49, and 50 recite two electrode regions between which the charge transfer regions and the light absorption region are positioned, and that the claims of Den et al are not seen to teach or suggest this feature. However, as noted above, the use of electrodes is conventional in the art as is shown by Skotheim.

Applicant argues that the dependent claims are patentable because they set forth additional aspects of the instant invention and are dependent from the independent claims. However, this argument is not deemed to be persuasive because, as noted in the double patenting rejections above, the dependent claims are rendered obvious by the claims of Den et al in view of Skotheim, by the claims of Den et al in view Skotheim and further in view of Tchernev and Akuto et al, and by the claims of Okura et al in view of Skotheim.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Motohiro et al (U.S. Patent 5,571,612) teaches an anisotropic nanophase composite material, which, as seen in Figure 3, could be considered to be an aggregate of acicular crystals (2, 3). However, the inorganic oxides in Motohiro et al are not used as semiconductors, and the semiconductors are listed at col. 4, lines 44-47. Semiconductors, not inorganic oxide, are used to prepare a photovoltaic device (col. 4,

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lines 52-54; and Example 3 at cols. 8-9), and thus, Motohiro et al does not lead a skilled artisan to the instantly claimed invention.

Salafsky (U.S. Patent 6,239,355) does not lead a skilled artisan to an aggregate of acicular crystals.

Lupo et al (U.S. Patent 6,281,430) uses columns of discotic liquid crystals for its solar cell, but does not prepare and aggregate of acicular crystals. Furthermore, SiO<sub>x</sub> that can be used to prepare columns (col. 4, lines 35-41) is not a metal oxide.

Kalkan et al (U.S. 2002/92441), Curtin (U.S. 2004/0003838), and Scher et al (U.S. 2004/0118448) have later filing dates than the instant effective U.S. filing date of September 20, 2000.

The following U.S. Patents and U.S. Patent Applicant Publications are also hereby made of record: 2003/0102024, 6,683,244, 6,720,202, 2004/0084080, 2004/0221888, 6,849,797, 6,849,798, and 6,852,920.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 571-272-1338. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.  
Status information for unpublished applications is available through Private PAIR only.  
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alan Diamond  
Primary Examiner  
Art Unit 1753

Alan Diamond  
February 24, 2005

A handwritten signature in black ink, appearing to read "Alan Diamond".